



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,377	05/30/2001	Nick J. Pudar	GP-300259	7233
60770 7590 08/30/2010 General Motors Corporation c/o REISING ETHINGTON P.C. P.O. BOX 4390 TROY, MI 48099-4390				
EXAMINER				
MYHRE, JAMES W				
ART UNIT		PAPER NUMBER		
3688				
MAIL DATE		DELIVERY MODE		
08/30/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/870,377
Filing Date: May 30, 2001
Appellant(s): PUDAR, NICK J.

James D. Stevens
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 12, 2010 appealing from the Office action mailed June 10, 2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 26-42

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

5,664,948	DIMITROADIS et al	9-1997
5,774,170	HITE et al	6-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

- (a) Claims **26-42** are rejected under 35 USC 103(a) as being unpatentable over Dimitriadis, US Patent 5, 664, 948 in view of Hite, US Patent 5,774,170A.

As per claim 26, Dimitriadis discloses a system, wherein an advertising information is pre-loaded into a collection of remote receiving and presentation devices (40) (radios installed in vehicles). A presentation command (presentation condition or selection criteria) is broadcast over a radio broadcast 20 to a device (40) that causes presentation, in audio or text format, of at least one of the advertisements stored in the memory of the device (40) **originally received from a first broadcast stream** (monitoring a radio broadcast stream for transmitting presentation condition data or referenced index for a stored advertisement to device 40, which triggers the presentation of the at stored advertisement). Each stored advertisement is also associated with one or more presentation conditions (play conditions) causing, when detected for example in a radio broadcast (stream **or content**) transmitted to a device 40 (or a group of devices 40),

automatic presentation or play via the device 40 speaker or display through its screen of the corresponding advertisement matching the presentation conditions present in the radio broadcast stream. Such presentation conditions include proximity to a given location (detecting the presence of the vehicle 10 having installed therein device 40 in a geographical area of interest), scheduled periodic presentation, time of day presentation, and a variety of other conditions detectable at the remote presentation device 40 (including detecting the presence of a command in a radio broadcast transmitted to the device 40). Further, the advertising presentation system requires a single broadcast signal transmission of a given advertisement from radio broadcast 20 (radio facility) for permanent storage in the memory of the device 40, but provides multiple presentations or plays of the advertisement at the presenting devices 40. Here, the advertiser enjoys efficient use of broadcast signal transmission time (See abstract; **col. 2: 9-67**).

In general, Dimitriadis teaches an advertising system comprising a radio broadcast or signal transmission facility providing voice and data broadcast signals 22 and 26 respectively (advertisements or messages) and a plurality of remote receiving devices 40 (vehicle radio systems) collecting said voice and data signal broadcasts 22 and 26 respectively, each of said receiving devices 40 storing **selected** ones of said voice and data broadcasts 22 and 26 as stored advertisements therein in association with index values (or secondary selection data) (wherein the selected advertisements are chosen for storage according to certain criteria, such as geographical areas of interest to a specific device 40, **and wherein each advertisement has an associated index value**) whereby subsequent transmission within at least one of said voice and data broadcasts (in-line advertisements) references said index values, which indicate which stored advertisements should be retrieved from the memory of device 40 and played

or outputted thereat, and causes said remote receiving device 40 to retrieve therefrom and present or play one or more corresponding stored advertisements when there is a match between an index value transmitted within an incoming (voice) radio broadcast and an index value related to a stored advertisement (transmitting a radio broadcast stream with a reference to an index value to a device 40 and if there is a match between the transmitted reference index value in the broadcast and an index value stored in the memory of the device 40 in conjunction with an advertisement, then the system is operable to retrieve therefrom and play or present the corresponding stored advertisement).

Each of said remote receiving devices 40 stores a plurality of advertisements received a first broadcast stream, each associated with an index value, uniquely identifying each advertisement, whereby said broadcast facility triggers presentation play of a selected stored advertisement at a selected remote receiving device 40 by broadcasting a command to the selected receiving device 40 in conjunction with a selected index value. Further, each stored advertisement is associated with a condition for presentation, include at least one of a schedule of presentation, proximity to a designated location, **and time of day (primary and secondary selection data)**, and each remote receiving device 40 monitors current conditions, compares current conditions to said conditions for advertisement presentation, and presents a stored advertisement upon finding a match between a current condition and a condition for presentation. In short, the present system relates generally to vehicle information and particularly to vehicle information collection and presentation (See claims 1-5; col. 2: 3-29).

In summary, Dimitriadis teaches an advertising system comprising a radio signal transmission facility providing voice and data broadcast signals (first radio broadcast

stream) and a plurality of remote receiving devices 40 collecting, via coupled antenna 42 of figs. 1 and 2, said voice and data signal broadcasts, each of said receiving devices storing selected portions of at least one of said voice and data broadcasts as stored advertisements in the memory of devices or receivers 40 in association with index values (CID type) whereby subsequent transmission within at least one of said voice and data broadcasts (second radio broadcast stream) references or incorporates index values, which causes at least one remote receiving device 40 to retrieve therefrom and present/play or output thereat a corresponding stored advertisement when there is a match between the incoming index value inserted into a second incoming radio broadcast stream (voice content) and an index value related to a stored advertisement (See claims 1-3 of the current reference).

See in general col. 2: 62 to col. 9: 44.

As per claim 26, Dimitriadis does not expressly disclose providing the second one of the radio broadcast streams or the second radio broadcast stream that includes an audio content containing intermittent slots (i.e. breaks in conventional audiovisual broadcast or radio/TV programming) each identified by a marker (i.e. index value or CID) inserted in the broadcast stream and presenting a stored advertisement accordingly.

However, Hite discloses, in a first preferred embodiment of his present system and process, an individually addressable digital recording device (RD) or subscriber's receiver with a unique address is installed at the display site in a television or radio receiver, VCR, display device or set-top-box or modular decoder associated with the media provider (cable, DBS, telephone, etc.). One or more commercial identifier (CID) codes (index values) are transmitted to

and recorded by the RD (local memory or cache) of the subscriber's site or viewer's unit in advance of a commercial broadcast (advertisement transmission). These codes will be used to "tell" the home display or viewer's unit which upcoming commercials/advertisements or (advertising objects) to store for subsequent play or display at the subscriber's site and which advertisements to ignore or discard (because they are incompatible) (Col. 5: 40-50; col. 6: 10-59).

In a second preferred embodiment of the present system and process, an individually addressable digital recording device (RD) or memory with a unique address (location address) is installed at the display site (subscriber site) in the television receiver, VCR, display device set-top-box or modular decoder associated with the video provider (cable, DBS, telephone, etc.). CID codes (local conditions) chosen for a particular display site (consumer site) are transmitted to and stored in an in-home storage at the display site (storing local conditions in the memory at the subscriber site). Commercials (advertisement objects) are subsequently transmitted to the in-home storage device with sufficient capacity to hold or store one or more commercials (advertisement objects), coupled to related image objects or image links, graphics or video, prior to display (transmitting and receiving advertisements at the subscriber site to be recorded in the memory or storage means for later retrieval and display based on some preset criteria or local conditions).

The commercials/advertisements (advertisement objects) could be in analog form, but it is more efficient of transmission and storage capacity to digitize and compress the commercials prior to transmission and storage at the subscriber site. Attached to each commercial are (CID)

codes indicating the conditions and rules (local conditions), e.g., date, day-part, network, program context, etc. required to display the commercial(s),

The codes (data elements) of the commercials transmitted to or received at the subscriber site are first compared to the codes previously stored in local memory or storage means (RD) at the subscriber site. The commercial or advertisement transmitted to the subscriber site or display unit that is found to match a previous CID code in the local memory is then stored in the storage means (local memory) RD at the display site (subscriber) for subsequent retrieval and display. If there is no match, then the incoming commercials or advertisements (advertising objects) will be ignored or discarded for being incompatible or not suitable for the local site or subscriber site/display unit. Note that the CIDs (CID codes) and display rules would be stored in a storage known as an Ad Queue in the commercial processor (local memory) at the display unit or subscriber site. See col. 6: 60 to col. 7: 14; col. 7: 15-50.

Commercial time or spots when addressable ads (advertisement objects) can be displayed will have unique identifier codes (CIDs). These codes will be part of the conditions required for displaying the addressable spots. These eligibility codes could be applied, i.e., transmitted by the network or locally available in local-avail spots. The program delivery system would broadcast, within a programming, a default-commercial in the spot eligible for the locally stored addressable ad. This spot would air in a home or display that was not targeted for an addressable ad in that time period. The commercial processor CP in the home (subscriber's receiver) would look for the CID in each Incoming (default) commercial at a break during a broadcast program. If there was a CID at a break, then the processor would apply the display rules for the addressable ads locally stored in the subscriber's receiver. If there was an ad to display, then the

CP would substitute the locally stored addressed ad for the ad in the broadcast and eliminate or discard it from the ad queue as necessary (COL. 7: 16-30).

Here, predetermined codes are transmitted to the display site and stored therein; commercials are then sequentially transmitted to the display site prior to the time of their intended use. Appropriate storage is provided at the display site to store one or more of the commercials selected by matching the commercial's CID with that CID determined as appropriate for the display site. The broadcast with a break for a target commercial may then be transmitted with codes in the break. If a match is found and only one commercial is stored, it may be displayed one or more times, depending on whether a frequency code is included. If a registration or certification code is included, that code is returned upstream to the signal origination site when commercials successfully play. The commercial will then be replaced with another (update). If storage for multiple commercials is provided, they are downloaded and used appropriately (col. 7: 35-51).

In general, processed commercials are conveyed by electrical and/or optical connection 108 to a Recording Device 110 of fig. 2 for later retrieval and playback at a suitable time in the Processed Commercials Playback Device 146 of fig. 2. Such recording and playback devices for analog or digital video and/or audio segments are well known in the industry (col. 10: 11-16). See col. 9: 43 to col. 10: 32.

In summary, in the second preferred embodiment, predetermined codes (CID codes or index values) are transmitted to the display site/subscriber site or receiver and stored therein. Thereafter, commercials or advertisements (advertising objects) are sequentially transmitted to the display site prior to the time of their intended use or display.

Appropriate storage is provided at the display site to store one or more of the commercials selected by matching a commercial's CID with a locally stored CID. Through this process, a first group of advertisements can be generated and stored locally for later retrieval and display. Further, a broadcast with a break for a target commercial (advertising slot) may be transmitted with codes in the break, which triggers the retrieval and display of the stored or the first group of advertisements based on a CID match between a break CID or code and a stored commercial/advertisement CID or code. For instance, if a match is found, between a code in the break and a stored commercial code or only one related commercial is stored, then the commercial is displayed one or more times, depending on whether a frequency code is included. If a registration or certification code is included, then that code is returned upstream to the signal origination site or transmission site when commercials are successfully played. The commercial will then be replaced with another. If storage for multiple commercials is provided, they are downloaded and used appropriately (Col. 7: 35-50; col. 9: 16-20; col. 4: 46-51).

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the teachings of Hite into the system of Dimitriadis so as to store in the memory of remote devices or receivers 40, along with advertising data, a plurality of CID codes or index values related to a plurality of stored advertisements received during first broadcast streams and to transmit to at least one receiver 40 a second or subsequent voice broadcast stream (22) having at least a break or advertising slot, indicative of an advertising opportunity, and at least one corresponding CID or index value (marker) inserted therein, wherein one stored advertisement is retrieved and played or outputted thereat when a break occurs in the incoming

second voice broadcast and the index value or the CID embedded in the break spot matches an index value/CID or marker related to the retrieved advertisement and based on other presentation commands such as the vehicle 10 current geographic location proximate a local advertiser, thereby taking advantage of conventional breaks that often occur in (voice) radio broadcast streams to present targeted advertisements to mobile users of devices or receivers 40 as they travel in vehicle 10, coupled to receivers 40, along a geographic location of interest, while enabling advertisers to have their messages embedded in voice broadcast streams during intermittent breaks, inserted therein, and presented to users of receivers 40 and the system owner to increase his economic bottom line by charging the advertisers for presenting their messages to the operators of vehicle 10.

As per claim 42, Dimitriadis does not expressly disclose transmitting by a vehicle communication device data confirming the playing (playback) of the advertisement, retrieved from the memory of the vehicle radio system, and receiving by a central facility the transmitted data (uploading the activity log or transaction data associated with each displayed advertisement to the Central Facility or broadcast system 20) (i.e. a vehicle communication device operable to transmit identification data received from the first radio broadcast stream that uniquely identifies the accessed or played radio advertisement). However, Hite discloses a system and method for delivering targeted advertisements to specific consumers, in a cable TV environment, based on the specific customers' desires, needs, interest, wants or psychographic profile or preferences. In one embodiment, a set top box or delivery mechanism associated with a cable company and located at a customer's site receives a tagged content or TV program with a tagged advertisement

(advertisement having a unique CID) from a content provider or Media Origination Facility 300 of fig. 1 wherein the set top box first displays the TV program along with the flagged or tagged advertisement or advertisement having a unique CID code (commercial ID) if the CID code corresponding to the embedded advertisement matches a CID code pre-recorded or stored in the set top box memory and wherein the stored CID represents the customer's psychographic profile or preference. And if there is a CID code match, then the set top box causes the said advertisement to be displayed on the customer's TV screen during a commercial break in the TV program as originally scheduled (figs. 1-2; col. 3: 65 to col. 4: 11; col. 4: 33-39; col. 5: 39-67; col. 8: 64 to col. 9: 42; col. 13: 47-53). In one embodiment, a memory device RD, associated with the home display unit, pre-records the advertising information along with the related CID codes and the system is operable to retrieve therefrom and display an advertisement during a commercial break in a transmitted programming or broadcast when a CID in the transmission matches a CID stored in the RD device (col. 6: 60 to col. 7:34).

It is further to be understood that additional codes, such as a **frequency** indicator code representing the number of times an advertisement is to be successfully displayed, are appended to the CID code (representing a customer and/or a commercial) for enhancing the system. The frequency indicator code, stored locally on the set top box memory at the customer's site, is appended to a commercial's CID code wherein the content (counter) of the frequency indicator code decrements for each successful display of the associated commercial or advertisement and when the frequency indicator code reaches zero, the advertisement will no longer be displayed by the set top box. In other words, the number of times a particular advertisement should be displayed to the user or the frequency of viewing (frequency code) by the viewer a particular

advertisement is appended to the CID code, representing the viewer's or user's psychographic profile or preference information, stored in the permanent memory (preference information storage) of the set-top box or display device (content delivery mechanism).

Furthermore, a registration code could be added to the CID code and stored at the point of display. When such a commercial is successfully displayed, the registration code is communicated back upstream to the signal origination site. A time and date stamp is added. Two levels of registration are possible. In the simpler level of registration, a count is accumulated at the origination point or some other suitable place indicating the total number of commercials successfully displayed at all locations. Viewer identities are not tabulated. In the second level of registration, a viewer identification number is included in the acknowledgment messages centrally collected. A certification code could also be added to the CID code and stored at the point of display. When such a commercial is successfully displayed, the certification code is communicated back upstream to the signal origination site. A time and date stamp is added. In the case of certification, the viewer responds to the advertisement. This response could be to answer a question, to merely make an acknowledgment, or to request a coupon or other item of value. This indicates that not only has the commercial been successfully displayed, but it has also been viewed, recognized, and acted upon.

Additionally, there are several options for the upstream transmission of registration or certification codes. This code could be transmitted upstream at the time the commercial was successfully received. Alternatively, the fact that it was received could be stored at the receive site and relayed to the signal origination site upon request or at a pre-programmed more convenient time. Several options for upstream communication exist. These include two-way

cable systems, **radio transmissions**, telephonic communication, or the physical conveyance of a printed report, a magnetic, optical, electronic or other recorded report.

In summary, with the present system, television (and/or radio) and advertising are enhanced by targeting, delivering and displaying electronic advertising messages (commercials) within specified programming in one or more pre-determined households (or on specific display devices) while simultaneously preventing a commercial from being displayed in other households or on other displays for which it is not intended. Commercials can be delivered to specified homes or displays via either over-the-air broadcast or wired delivery systems.

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the teachings of Hite into the system of Dimitriadis so as to store a frequency code register (counter) capable of counting the number of times a filtered or matched advertisement is successfully displayed and a certification code indicative of the successful display of an advertisement along with the user's preference information (profile), advertising selection or presentation criteria and associated index values on the user's vehicle device 40 memory, wherein the content of the frequency code counter increments each time the filtered and matched advertisement is successfully displayed or played to the user until it reaches a preset value and wherein the certification code is communicated from the vehicle radio communication system upstream or upward to the Central Facility for further processing and marketing analysis, thereby using by the Central Facility the transaction data, read from the transmitted registration code, frequency code and certification code, associated with the displayed or played advertisement not only to prepare accurate billing statements for the participating advertiser of the displayed advertisement and to schedule further delivery of advertisements to

the mobile unit or device 40, but also to further target the user of the mobile unit or mobile vehicle 10 by filtering incoming broadcasts or advertisements in accordance with the user or operator of the mobile vehicle 10 designated criteria and the user's exposure to advertisements recorded in the memory of the vehicle device 40 or displayed or played advertisements to automatically select and store without the user's input specific advertisements or broadcast data 26 transmitted over the radio broadcast system 20 in the memory or customized database of the information device 40 of the mobile unit or mobile vehicle 10, while measuring the effectiveness of the system.

As per claims 27-41, Dimitriadis discloses a system, wherein an advertising information is pre-loaded into a collection of remote receiving and presentation devices (40) (radios installed in vehicles). A presentation command (presentation condition or selection criteria) is broadcast over a radio broadcast 20 to a device (40) that causes presentation, in audio or text format, of at least one of the advertisements stored in the memory of the device (40) **originally received from a first broadcast stream** (monitoring a radio broadcast stream for transmitting presentation condition data or referenced index for a stored advertisement to device 40, which triggers the presentation of the at stored advertisement). Each stored advertisement is also associated with one or more presentation conditions (play conditions) causing, when detected for example in a radio broadcast (stream **or content**) transmitted to a device 40 (or a group of devices 40), automatic presentation or play via the device 40 speaker or display through its screen of the corresponding advertisement matching the presentation conditions present in the radio broadcast stream. Such presentation conditions include proximity to a given location (detecting the

presence of the vehicle 10 having installed therein device 40 in a geographical area of interest), scheduled periodic presentation, time of day presentation, and a variety of other conditions detectable at the remote presentation device 40 (including detecting the presence of a command in a radio broadcast transmitted to the device 40). Further, the advertising presentation system requires a single broadcast signal transmission of a given advertisement from radio broadcast 20 (radio facility) for permanent storage in the memory of the device 40, but provides multiple presentations or plays of the advertisement at the presenting devices 40. Here, the advertiser enjoys efficient use of broadcast signal transmission time (See abstract; **col. 2: 9-67**).

In general, Dimitriadis teaches an advertising system comprising a radio broadcast or signal transmission facility providing voice and data broadcast signals 22 and 26 respectively (advertisements or messages) and a plurality of remote receiving devices 40 (vehicle radio systems) collecting said voice and data signal broadcasts 22 and 26 respectively, each of said receiving devices 40 storing **selected** ones of said voice and data broadcasts 22 and 26 as stored advertisements therein in association with index values (or secondary selection data) (wherein the selected advertisements are chosen for storage according to certain criteria, such as geographical areas of interest to a specific device 40, **and wherein each advertisement has an associated index value**) whereby subsequent transmission within at least one of said voice and data broadcasts (in-line advertisements) references said index values, which indicate which stored advertisements should be retrieved from the memory of device 40 and played or outputted thereat, and causes said remote receiving device 40 to retrieve therefrom and present or play one or more corresponding stored advertisements when there is a match between an index value transmitted within an incoming (voice) radio broadcast and an index

value related to a stored advertisement (transmitting a radio broadcast stream with a reference to an index value to a device 40 and if there is a match between the transmitted reference index value in the broadcast and an index value stored in the memory of the device 40 in conjunction with an advertisement, then the system is operable to retrieve therefrom and play or present the corresponding stored advertisement).

Each of said remote receiving devices 40 stores a plurality of advertisements received a first broadcast stream, each associated with an index value, uniquely identifying each advertisement, whereby said broadcast facility triggers presentation play of a selected stored advertisement at a selected remote receiving device 40 by broadcasting a command to the selected receiving device 40 in conjunction with a selected index value. Further, each stored advertisement is associated with a condition for presentation, include at least one of a schedule of presentation, proximity to a designated location, **and time of day (primary and secondary selection data)**, and each remote receiving device 40 monitors current conditions, compares current conditions to said conditions for advertisement presentation, and presents a stored advertisement upon finding a match between a current condition and a condition for presentation. In short, the present system relates generally to vehicle information and particularly to vehicle information collection and presentation (See claims 1-5; col. 2: 3-29).

In another embodiment, Dimitriadis teaches a paging system that supports group addressing whereby a single paging data packet transmission or broadcast may be addressed to groups of receiving devices 40 (to listeners of devices 40). Accordingly, advertising presentation may be accomplished relative to listeners defined as groups. For example, by developing a profile for the users of each device 40, e.g., age, class of neighborhood (demographics), typical

products purchased (purchase history) and the like, as is typically done in advertising strategies, the advertiser defines groups of listeners. By loading into receiving devices 40 advertisements tailored to group needs (interests), the advertiser targets specific audiences with specific advertising messages. Moreover, one advertisement may be loaded into one group of receiving devices 40 while a second advertisement is loaded into a second group of receiving devices 40. Even though different advertisements are loaded into different receiving devices 40, all such advertisements may be associated with the same index. Accordingly, issuance of the PRESENT command 500c relative to such common index value causes distinct advertisement presentation for different groups of listeners. As may be appreciated, the radio signal transmission time associated with issuing the PRESENT command 500c is quite small as compared to similar advertisement broadcast time required to deliver by conventional means the same advertisement presentation, i.e., broadcast time required to present the advertisement to listeners currently tuned to the broadcast facility. Thus, an improved method and apparatus for message or advertisement presentation has been herein shown and described. Advertisement information is disseminated widely by radio signal broadcast to a population of receiving devices 40. The receiving devices 40 store this advertising information and present such information **multiple times** without requiring repeated radio signal transmission from the facility. In this manner, advertising presentation is made efficient with respect to radio transmission resources, and therefore less costly in regard to the costs associated with transmission of advertisement by radio signal (Col. 9: 45 to col. 10:20).

See in general col. 2: 62 to col. 9: 44.

(10) Response to Argument

(a) The Appellant initially argues that it was improper for the Examiner to reject Claims 26-42 because in a previous Board Decision (April 30, 2008) "the Board overturned a § 102 rejection of claims 26-41 based on Dimitriadis alone, and overturned a § 103 rejection of claim 42 on the basis of Dimitriadis and Hite." (pages 6-8). The Appellant also argues that the rejection is improper because the Board entered a new grounds of rejection using these two references for other claims, but not for Claims 26-41; thus implying that the two references could not be combined to read on the claims. The Examiner first notes that since Claims 26-41 were previously rejected under Dimitriadis alone, the Board had no obligation to address whether or not the combination of that reference with another cited reference was obvious or not. The lack of a new grounds of rejection by the Board does not automatically eliminate such combination upon further review of the references. The Examiner further notes that while it may be unusual to reopen prosecution after a Decision with the same references as were previously used, but in a different manner, it is not without precedence. Patentability is not determined by which references were cited or when, but rather by the disclosures of those references. The Examiner, after further review of the Board Decision and the references, believes that Hite discloses the claim limitations that the Board had found missing in Dimitriadis and, thus, the rejection is proper.

(b) The Appellant argues in reference to Claim 26 that Dimitriadis does not disclose that "the audio content sent to the vehicle radio includes the received radio broadcast together with the inserted advertisement, (emphasis Appellant's), rather that

Dimitriadis discloses that "the advertising is sent to the speaker amplifier 68 independently of the received voice broadcast". The Examiner notes that Claim 26 recites a system with three components: (1) a vehicle radio that receives and outputs audio data; (2) a radio broadcast receiver with an antenna for receiving two or more broadcast streams; and (3) an advertising control unit that records (stores) the advertisements incoming through the radio broadcast receiver and accesses the stored advertisements to insert one into the advertising slot identified by the received marker, thus sending both the regular broadcast stream and the advertisement to be output through the vehicle radio. Dimitriadis discloses a radio broadcast receiver (voice radio and data radio, Figure 2, items 62 and 64) having an antenna (Figure 2, item 42) that receives incoming voice and data broadcast streams; an advertising control unit (microprocessor, Figure 2, item 60) that causes the received advertisements to be stored in a database (memory source, Figure 2, item 90), retrieves the advertisements from the database and places one or more of them into a queue within the Advertisement Presentation module (Figure 2, item 104), and finally causes the advertisements to be inserted into the appropriate advertising slots within the regular audio broadcast stream and sent to the vehicle radio (amplifier, Figure 2, item 68) to be played on the vehicle radio speakers (Figure 2, item 70). The main contention between the Appellant's interpretation of Dimitriadis and the Examiner's interpretation is the identity of the various system components. The Appellant appears to be equating the Advertisement Presentation module (104) with the claimed advertising control unit; whereas the Examiner believes that the microprocessor (60) is the control unit that

merely uses the Advertisement Presentation module as a queue for readying the advertisements for insertion into the regular audio broadcast stream. Throughout the Specification, Dimitriadis discusses passing the advertisements, data signals, and other control messages through the microprocessor. Dimitriadis further discloses that "microprocessor 60 orchestrates generally operation of device 40" and "it will be understood that such device includes additional supporting hardware features such as analog-to-conversion and digital-to-conversion and other such related input/output hardware required to support the features described herein" (column 4, lines 41-47). Thus, in both the Appellant's system and in Dimitriadis' system the device at the user's location receives incoming audio (containing regular audio broadcasts) and data streams (containing ads), stores the ads, and subsequently inserts the ads into the regular audio broadcast stream at an appropriate location, and outputs the combined audio stream to the user's vehicle radio (e.g. the amplifier and speakers). As per the Appellant's argument in reference to the markers within the broadcast stream, the Examiner notes that Hite has been cited as showing this feature both in the Final Rejection and in the previous Board Decision. The Examiner further notes that Hite also discloses inserting advertisements into the broadcast stream at the marked locations and transmitting the combined data stream to the vehicle radio.

(c) The Appellant argues in reference to Claim 31 (page 10) that Dimitriadis sends the advertising "to speak amplifier 68 independently of the received voice broadcast. It is not sent to the radio receiver 64.". The Examiner notes that the radio broadcast receiver in Claim 26 consists of the "antenna for receiving two or more radio

broadcast streams" and the advertising control unit accesses the stored advertisement and inserts it "into the advertising slot identified by the received marker". In Dimitriadis, as discussed above, the microprocessor 60 controls the receipt of the broadcast streams (from the voice radio 64, which includes the antenna for receiving the broadcast streams) and the advertisements, stores the advertisements into the database 90, retrieves an appropriate advertisement from the database, and inserts it into the regular audio broadcast stream as it is being sent to the vehicle radio (amp 68 and speakers 70). It is inherent that a processor must be used to control the insertion of the advertisements into the broadcast stream. A receiver, by itself, is just that - a receiver, not a processor. Of course, it is obvious that a processor, such as microprocessor 60, may be connected to the receiver to control the insertion, such as has been done by Dimitriadis. Whether the processor is internal or external to the actual physical receiver device would not affect its function at all. The processor would still be able to insert the advertisements into the appropriate slots within the broadcast stream before it is delivered to the vehicle radio. Furthermore, it would have been a trivial matter for one having ordinary skill in the art at the time of the invention to move an external processor into the receiver or vice versa. For example, cable television for many years required a processor within an external control box (set-top box) in order to allow a user to view the cable television broadcast streams. However, within the past 10-20 years many television manufacturers have moved the processor within the television cabinet itself so as to eliminate the need for an external box. Thus, it would have been obvious to place the processor that is inserting the advertisement into the

radio broadcast stream in an external device (e.g. a control box) or within the radio receiver (the device containing the antenna receiving the broadcast stream) as desired.

(d) The Appellant again argues in reference to Claim 32 (page 10) that Dimitriadis does not disclose sending the advertisement to the radio broadcast receiver. This has been discussed in reference to Claim 31 above.

(e) The Appellant argues in reference to Claim 33 (pages 10-11) that Dimitriadis does not disclose "the advertising control unit 24 is interposed between the radio broadcast receiver 18 and the vehicle radio 20.". However, the Examiner notes that, as discussed above in reference to Claim 26, Dimitriadis discloses the microprocessor 60 (advertising control unit) controls the operations of the device to include receiving advertisements, storing advertisement, retrieving an appropriate advertisement, and inserting the advertisement into the broadcast stream. Inherently this is taking place sometime (and somewhere) between the receipt of the broadcast stream by the radio broadcast receiver and the output of the signal to the vehicle radio (amp and speakers). The Examiner further notes that the Appellant previously argued in reference to Claim 31 that Dimitriadis did not disclose the insertion step taking place within the radio broadcast receiver, but is now arguing that Dimitriadis also doesn't disclose the insertion step being performed outside of the radio broadcast receiver, i.e. by the advertising control unit (microprocessor). Inherently, the insertion must take place in one of those places (internal or external to the radio broadcast receiver) before it can be sent to the output device (vehicle radio).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
JWM
August 25, 2010

/James W Myhre/
Primary Examiner, Art Unit 3688

Conferees:

John Weiss/JOHN G. WEISS/
Supervisory Patent Examiner, Art Unit 3688

Eric Stamber/E. W. S./
Supervisory Patent Examiner, Art Unit 3622